

NOTE: CHANGES MADE BY THE COURT

Closed

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA, WESTERN DIVISION

INSURANCE SERVICES OFFICE,
INC.,

Plaintiff,

v.

ISO RATER CORPORATION,

Defendant.

Case No. 2:16-cv-01525-JFW-Ex

**JUDGMENT AND PERMANENT
INJUNCTION**

Judge: Hon. John F. Walter

Complaint Filed: March 4, 2016
Default Judgment: August 30, 2016

1 WHEREAS, the Court entered its ORDER GRANTING PLAINTIFF'S
2 APPLICATION FOR ENTRY OF A DEFAULT JUDGMENT AND PERMANENT INJUNCTION BY
3 THE COURT AGAINST DEFENDANT on August 30, 2016 (D.I. 21, 22) ("Default
4 Judgment Order"); and

5 WHEREAS, the Court entered its ORDER GRANTING PLAINTIFF'S MOTION TO
6 FIX AMOUNT OF ATTORNEYS' FEES AND NON-TAXABLE COSTS on October 21, 2016
7 (D.I. 30, 31) ("Attorneys' Fees Order"); and

8 WHEREAS, in its Attorneys' Fees Order, the Court directed Plaintiff
9 Insurance Services Office, Inc. ("Plaintiff" or "ISO") to submit a proposed
10 Judgment to the Court consistent with its Default Judgment Order and its Attorneys'
11 Fees Order.

12 **IT IS HEREBY ORDERED, ADJUDGED, AND DECREED** that the
13 following Judgment and Permanent Injunction in favor of ISO and against
14 Defendant ISO Rater Corporation ("Defendant") is hereby granted:

15 1. The Court has jurisdiction over the subject matter of this action under
16 the laws of the United States concerning actions relating to federal questions,
17 28 U.S.C. § 1331, and trademarks, 28 U.S.C. § 1338(a). The Court also has
18 supplemental jurisdiction pursuant to 28 U.S.C. §§ 1338(b) and 1367 over ISO's
19 claims that arise under the laws of the State of California.

20 2. The Court has personal jurisdiction over Defendant because Defendant
21 is located in this district.

22 3. Venue is proper in this district under 28 U.S.C. §§ 1391(b), (c), and (d)
23 because a substantial part of the acts giving rise to ISO's claims occurred in this
24 district, and Defendant is subject to personal jurisdiction in this district.

25 4. As set forth in the First Claim for Relief of ISO's Verified Complaint
26 for Damages and Injunctive Relief (D.I. 1) ("Complaint"), Defendant has infringed
27 and continues to infringe ISO's rights in its federal trademark registrations, in
28 violation of Section 32 of the Lanham Act, 15 U.S.C. § 1114. Defendant's conduct

1 is likely to cause confusion, mistake and deception among the general purchasing
2 public, and interfere with ISO's ability to use ISO's Marks¹ to indicate a single
3 quality-controlled source of goods and services.

4 5. As set forth in the Second Claim for Relief of the Complaint,
5 Defendant has infringed and continues to infringe ISO's rights in violation of
6 Lanham Act § 43(a), 15 U.S.C. § 1125(a). Defendant's conduct has interfered with
7 and will continue to interfere with ISO's ability to use ISO's Marks and the ISO
8 trade name to indicate a single quality controlled source of goods and services.
9 Defendant's acts as alleged herein also constitute false designation of origin, unfair
10 competition, and false advertising in violation of Lanham Act § 43(a), 15 U.S.C. §
11 1125(a).

12 6. As set forth in the Third Claim for Relief of the Complaint,
13 Defendant's use of and expected continued control over the Infringing Domain
14 Name constitutes a violation of the Anticybersquatting Consumer Protection Act of
15 1999. Defendant unlawfully registered and misappropriated the Infringing Domain
16 Name with a bad faith intent to profit from ISO's Marks, and has wrongfully used
17 the Infringing Domain Name, which incorporates in whole or in part ISO's Marks,
18 which are protected under the laws of the United States.

19 7. As set forth in the Fourth Claim for Relief of the Complaint, Defendant
20 has, without authorization from ISO, adopted and used the Infringing Trade Name
21 and registered and used the Infringing Domain Name, both of which infringe ISO's
22 Marks and the ISO trade name, to advertise, distribute, sell and offer to sell
23 Defendant's Infringing Services. Defendant's acts as alleged in the Complaint are
24 likely to cause confusion, mistake, and deception to consumers as to the affiliation,
25 connection, or association of Defendant with ISO, and as to the origin, sponsorship,
26 or approval of Defendant's Infringing Services by ISO. Defendant's unauthorized

27 ¹ All terms defined in the Verified Complaint are used herein as defined in the
28 Verified Complaint.

1 acts constitute direct infringement of ISO's trademarks in violation of California
2 common law.

3 8. As set forth in the Fifth Claim for Relief of the Complaint, from its
4 offices in California, Defendant has disseminated or caused to be disseminated
5 advertisements and solicitations for Defendant's Infringing Services featuring the
6 Infringing Trade Name and using the Infringing Domain Name to advertise and
7 promote Defendant's Infringing Services. In doing so, Defendant has falsely
8 represented that there is an association, affiliation, connection or relationship with
9 ISO. No such association, affiliation, connection or relationship exists between ISO
10 and Defendant. Defendant's acts as alleged in the Complaint constitute the use of
11 deceptive, untrue and misleading advertising, of which Defendant knew or should
12 have known, thereby impairing ISO's goodwill and otherwise adversely affecting
13 ISO's business and reputation. These acts constitute false advertising under
14 California Business and Professions Code §§ 17500 and 17535, and California
15 common law.

16 9. As set forth in the Sixth Claim for Relief of the Complaint, ISO's
17 Marks and the ISO trade name are wholly associated with ISO due to its extensive
18 use of the marks and the trade name. As such, ISO is deserving of having ISO's
19 Marks and the ISO trade name adequately protected with respect to the conduct of
20 its business. Defendant's wrongful conduct as alleged in the Complaint constitutes
21 unfair competition and unfair business practices. Based on the wrongful, unlawful,
22 fraudulent and unfair acts described herein, Defendant is in violation of California
23 Business and Professions Code §§ 17200 and 17203.

24 10. As set forth in the Seventh Claim for Relief of the Complaint, ISO's
25 Marks and the ISO trade name are wholly associated with ISO due to its extensive
26 use of the marks and the trade name. As such, ISO is deserving of having ISO's
27 Marks and the ISO trade name adequately protected with respect to the conduct of
28 its business. Defendant's conduct has been wrongful, unlawful, unfair, fraudulent,

1 willful, wanton and malicious, done with intent, and in conscious disregard for the
2 rights of ISO in violation of California Civil Code § 3294(a).

3 11. As set forth in the Default Judgment Order, the Court orders the
4 following permanent injunctive relief that Defendant and its subsidiaries, officers,
5 agents, servants, directors, employees, partners, representatives, assigns,
6 distributors, successors, related companies, and attorneys, and all persons in active
7 concert or participation with the Defendant or with any of the foregoing, including
8 any corporation or other entity in which Defendant has or had any interest, or plays
9 or played any role in the creation, organization, funding, or operating of, be enjoined
10 from:

11 a. (i) use of any of ISO's Marks, the Infringing Trade Name,
12 and any other mark, designation, trade name or domain name that is similar
13 thereto and/or contains the term ISO or any of ISO's Marks, in connection
14 with the distribution, sale, advertising, marketing and promotion of the
15 Infringing Services; (ii) using in any way any other mark, designation, trade
16 name, or domain name so similar to ISO's Marks and/or the ISO trade name
17 as to be likely to cause confusion, mistake, and/or deception; (iii) falsely
18 designating the origin, sponsorship, or affiliation of ISO Rater's products or
19 services to suggest an association or affiliation with ISO, the ISO trade name
20 and/or ISO's Marks; (iv) falsely representing or otherwise holding itself out
21 as associated or affiliated in any way with ISO, ISO's Marks, and/or ISO's
22 Products and Services; and (v) use of the Infringing Domain Name,
23 <isorater.com>, the email extension @isorater.com, and other electronic
24 identifiers, URL addresses, or metatags that incorporate the term ISO or any
25 other terms that are confusingly similar to the term ISO or ISO's Marks;

26 b. Committing any act calculated to cause purchasers to
27 falsely believe that Defendant's goods and services are those sold under the
28 control and supervision of ISO, or are sponsored by, approved by or

1 connected with ISO, or are guaranteed by, warranted by, or produced under
2 the control and supervision of ISO;

3 c. Further infringing the ISO Marks and damaging ISO's
4 goodwill and business reputation;

5 d. Using, reproducing, distributing, displaying (including,
6 without limitation, over the Internet), selling, and marketing (or any direct or
7 indirect efforts in relation to any of the foregoing) ISO's copyrighted content
8 and materials, including but not limited to ISO's rates, rules, loss costs, forms,
9 manuals and analytics (collectively, the "Copyrighted Materials") or any
10 work that is substantially similar to ISO's Copyrighted Materials, including
11 but not limited to any derivative works based upon the Copyrighted Materials,
12 unless Defendant is licensed by ISO to use ISO's Copyrighted Materials; and

13 e. Assisting, aiding or abetting any other person or entity in
14 engaging or performing any of the activities referred to in paragraphs (a)
15 through (d) above.

16 12. As further set forth in the Default Judgment Order, Defendant shall
17 change its corporate name to a name that does not include the term ISO or any of
18 ISO's Marks.

19 13. As further set forth in the Default Judgment Order, Defendant shall
20 never seek registration of any trademark in the United States that includes the term
21 ISO, ISO's Marks, or any confusingly similar terms.

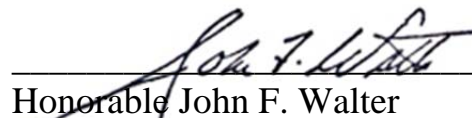
22 14. As further set forth in the Default Judgment Order, Defendant
23 acknowledges: (i) ISO's ownership of and the validity of ISO's Marks in the United
24 States; and (ii) ISO's ownership of and the validity of the Copyrighted Materials;
25 and agrees that it shall never challenge ISO's ownership and use of ISO's Marks
26 and/or the Copyrighted Materials, or the validity of ISO's Marks and/or ISO's right
27 of copyright in and to the Copyrighted Materials, or assist any third party in doing
28 so.

1 15. As further set forth in the Default Judgment Order, it is further ordered,
2 adjudged and decreed that Defendant promptly transfer the <isorater.com> domain
3 name (the "Transferred Domain Name") from the current registrar to the domain
4 registrar of the ISO's selection, pursuant to 15 U.S.C. § 1125(d)(2)(D)(i), and such
5 selected registrar shall thereafter register the Transferred Domain Name in the name
6 of ISO and provide Plaintiff with control as the registrant of the Transferred Domain
7 Names. ISO may, in its discretion, also provide a copy of this Order to the
8 applicable registrar and/or Internet Service Provider for the <isorater.com> domain,
9 separate and apart from Defendant's obligation to do so.

10 16. As set forth in the Attorneys' Fees Order, pursuant to 15 U.S.C.
11 §1117(a) and the Court's August 30, 2016 Order, ISO, as the prevailing party on its
12 Complaint, is awarded and shall recover attorneys' fees in the amount of Sixty
13 Thousand Nine Hundred and Eight Dollars and Fifty Cents (\$60,908.50) and non-
14 taxable costs in the amount of Eight Hundred Ninety Two Dollars and Forty Cents
15 (\$892.40) from Defendant.

16 17. This Judgment and Permanent Injunction is binding on Defendant and
17 any and all of its directors, officers, agents, servants, employees, representatives,
18 heirs, successors in interest, subsidiaries, related companies or individuals, affiliated
19 companies or individuals, assignees, and acquirers, including any acquirer of
20 substantially all of the assets of Defendant.

21
22
23 Dated: October 27, 2016


Honorable John F. Walter
DISTRICT COURT JUDGE